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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,697	05/17/2000	Paul W. Chau	SPY-022-C1	8633

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08/24/2005

David R Graham
1337 Chewpon Ave
Milpitas, CA 95035

EXAMINER

NGUYEN, VAN H

ART UNIT	PAPER NUMBER
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2194

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/574,697

Applicant(s)

CHAU ET AL.

Examiner

VAN H. NGUYEN

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**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/26/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9,41,43-54 and 57-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9,41,43-54 and 57-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 2-9, 41, 43-54, and 57-77 are presented for examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 26, 2005 has been entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 2-9, 41, 43-54, and 68-76 are rejected under 35 U.S.C. 102(b) as being anticipated by **Nara** (U.S. 5,168,151).

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5. As to claim 69, Nara teaches the invention as claimed including a portable integrated circuit card interface device (*an IC card reader/writer 16; col.3, lines 19-20 and fig.3*), comprising:

means for operably connecting (*electrically connected to...when inserted from card slot*) the interface device to an integrated circuit card (*IC card 10*) to enable communication (*reads or writes data from or in a memory of IC card 10*) between the interface device and the integrated circuit card (*see fig.3 and col.3, lines 21-27*);

- means for operably connecting (*connected to*) the interface device to a host device (*a terminal/a personal computer*) to enable communication between the interface device and the host device (*see fig.3 and col.3, lines 21-27*);

- means for operating (*off-line function*) the interface device in a standalone mode (*stand-alone mode*) in which the interface device is not operably connected (*being disconnected from*) to a host device (*a terminal/a personal computer/ an external apparatus*) to enable communication between the interface device and the host device (*col.2, lines 17-33; col.4, lines 46-51; and col.7, lines 60-67*); and

- means for operating (*on-line function*) the interface device in a connected mode (*on-line mode*) in which the interface device is operably connected to (*connected to*) a host device (*a terminal/a personal computer/ an external apparatus*) to enable communication between the interface device and the host device (*col.2, lines 17-33; col.3, lines 27-28; col.4, lines 46-51; and col.7, lines 60-67*).

6. As to claim 70, Nara teaches the standalone mode comprises a mode (*off-line mode*) in which the interface device is operably connected to (*electrically connected to...when inserted from card slot*) an integrated circuit card (*IC card 10*) to enable communication (*reads or writes data from or in a memory of IC card 10*) between the interface device and the integrated circuit card (*col.2, lines 17-33; col.3, lines 17-26 ; col.4, lines 46-51; and col.7, lines 60-67*).

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7. As to claim 71, Nara teaches a mode (*off-line mode*) in which the interface device is not operably connected (*being disconnected from*) to another device (*a terminal/a personal computer/an external apparatus*) to enable communication therebetween (*col.2, lines 17-33; col.4, lines 46-51; and col.7, lines 60-67*).

8. As to claim 72, Nara teaches operably connecting (*electrically connected to...when inserted from card slot*) the interface device (*an IC card reader/writer 16*) to an integrated circuit card (*IC card 10*) to enable communication (*reads or writes data from or in a memory of IC card 10*) between the interface device and the integrated circuit card (*col.3, lines 17-26 and fig.3*).

9. As to claim 73, it includes the same limitations as in claim 72 above, and is similarly rejected under the same rationale.

10. As to claim 74, it includes the same limitations as in claim 72 above, and is similarly rejected under the same rationale.

11. As to claim 75, it includes the same limitations as in claim 71 above, and is similarly rejected under the same rationale.

12. As to claim 76, it includes the same limitations as in claim 72 above, and is similarly rejected under the same rationale.

13. As to claim 43, the rejection of claim 69 above is incorporated herein in full.

Additionally, Nara further teaches:

- an application memory (*data memory 31...storing a user application program; col.3, lines 53-57; col.4, lines 25-40 and fig.3*);

- an application engine for managing one or more applications in said application memory (*reads or writes data from or in memory; col.3, lines 20-27*);

- an input/output module (*I/O signals supplied from I/C card reader/writer 16; col.3, lines 52-67*);

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- a host interface (*IC card reader/writer 16 connected to a terminal...connected to main body of a personal computer PC; col.3, lines 27-28 and fig.3*); and

- one or more integrated circuit card interfaces (*IC card reader/writer 16 is electronically connected to contacts portion 11 of IC card 10; col.3, lines 19-25 and fig.3*).

14. As to claim 2, Nara teaches a read-only memory (*ROM 29; col.3, lines 40-53*).

15. As to claim 3, Nara teaches an electrically erasable programmable read-only memory (*EEPROM 29; col.3, lines 40-53*).

16. As to claim 4, Nara teaches said application engine further comprises a microcontroller (*display controller; col.3, line 50 and col.4, line 56*).

17. As to claim 5, Nara teaches said microcontroller further comprises said application memory (*col.4, lines 56-60*).

18. As to claim 6, Nara teaches said input/output module comprises a microcontroller (*I/O control; col.4, line 22*).

19. As to claim 7, Nara teaches said application engine further comprises a custom circuit (*circuit 21; col.3, lines 58-66*).

20. As to claim 8, Nara teaches said custom circuit further comprises said application memory (*col.3, lines 53-57*).

21. As to claim 9, Nara teaches said input/output module further comprises a custom circuit (*circuit 33...can be desirably set and updated by a card holder; col.4, lines 52-55*).

22. As to claim 41, Nara teaches the interface device is portable (*portable; col.10, lines 6-7 and fig. 3*).

23. As to claim 44, Nara teaches a mode (*off-line mode*) of operation in which the interface device is operably connected to (*electrically connected to...when inserted from card slot*) an integrated circuit card (*IC card 10*) via one of the one or more integrated circuit card interfaces to

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enable communication (*reads or writes data from or in a memory of IC card 10*) between the interface device and the integrated circuit card (*col.2, lines 17-33; col.3, lines 17-26; col.4, lines 46-51; and col.7, lines 60-67*).

24. As to claim 45, it includes the same limitations as in claim 71 above, and is similarly rejected under the same rationale.

25. As to claim 46, Nara teaches a connected mode (*on-line mode*) of operation in which the interface device is operably connected (*connected to*) to a host device (*a terminal/a personal computer*) via the host interface to enable communication between the interface device and the host device (*see fig.3 and col.3, lines 21-27*).

26. As to claim 47, Nara teaches during the connected mode of operation the interface device is also operably connected to (*electrically connected to...when inserted from card slot*) an integrated circuit card (*IC card 10*) via one of the one or more integrated circuit card interfaces to enable communication (*reads or writes data from or in a memory of IC card 10*) between the interface device and the integrated circuit card (*col.2, lines 17-33; col.3, lines 17-26; col.4, lines 46-51; and col.7, lines 60-67*).

27. As to claim 48, it includes the same limitations as in claim 46 above, and is similarly rejected under the same rationale.

28. As to claim 49, it includes the same limitations as in claim 47 above, and is similarly rejected under the same rationale.

29. As to claim 50, it includes the same limitations as in claim 71 above, and is similarly rejected under the same rationale.

30. As to claim 51, it includes the same limitations as in claim 46 above, and is similarly rejected under the same rationale.

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31. As to claim 52, it includes the same limitations as in claim 47 above, and is similarly rejected under the same rationale.

32. As to claim 53, it includes the same limitations as in claim 46 above, and is similarly rejected under the same rationale.

33. As to claim 54, it includes the same limitations as in claim 47 above, and is similarly rejected under the same rationale.

34. As to claim 68, Nara teaches (*col.3, lines 50-52*) a display unit (*display unit 13*) and an input unit (*keyboard 12*).

Claim Rejections - 35 USC § 103

35. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

36. Claims 57-67 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nara** in view of **Tanaka** (U.S. 5,905,245).

37. As to claims 57, the rejections of claims 43 and 69 are incorporated herein in full. Nara does teach the interface device (*an IC card reader/writer 16; col.3, lines 19-20 and fig.3*). Nara, however, does not specifically teach enable one or more programs to be added to, and/or deleted from, the interface device.

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Tanaka teaches enable one or more programs to be added to, and/or deleted from, the interface device (*the IC card reading/writing control unit has... a pass-through function to control read-out/write-in processing for the IC card by an application unit in a host for the IC card reading/writing apparatus by receiving a pass-through command from the host; see the Abstract; col.5, lines 50-53; and col.7, line 52-col.8, line 4*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Tanaka and Nara because Tanaka's teaching would have provided the capability for simplifying the configuration of the IC card system, and largely reducing the cost required to build the system and contribute to flexibility of the configuration of the system.

38. As to claim 58, Nara teaches the interface device is operably connected to (*electrically connected to...when inserted from card slot*) an integrated circuit card (*IC card 10*) via one of the one or more integrated circuit card interfaces (*col.3, lines 17-26 and fig.3*). Refer to the discussion of claim 57 above for "enable one or more programs to be added to, and/or deleted from, the interface device."

39. As to claim 59, Nara teaches the interface device is operably connected (*connected to*) to a host device (*a terminal/a personal computer*) via the host interface (*see fig.3 and col.3, lines 26-27*). Refer to the discussion of claim 57 above for "enable one or more programs to be added to, and/or deleted from, the interface device."

40. As to claim 60, Nara teaches the interface device is operably connected to (*electrically connected to*) an integrated circuit card (*IC card 10*) via one of the one or more integrated circuit card interfaces (*col.3, lines 17-26 and fig.3*) and to (*connected to*) a host device (*a terminal/a personal computer*) via the host interface (*see fig.3 and col.3, lines 26-27*). Refer to the

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discussion of claim 57 above for “enable one or more programs to be added to, and/or deleted from, the interface device.”

41. As to claim 61, it includes the same limitations as in claim 45 above, and is similarly rejected under the same rationale.

42. As to claim 62, it includes the same limitations as in claim 44 above, and is similarly rejected under the same rationale.

43. As to claim 63, it includes the same limitations as in claim 45 above, and is similarly rejected under the same rationale.

44. As to claim 64, it includes the same limitations as in claim 46 above, and is similarly rejected under the same rationale.

45. As to claim 65, it includes the same limitations as in claim 47 above, and is similarly rejected under the same rationale.

46. As to claim 66, it includes the same limitations as in claim 46 above, and is similarly rejected under the same rationale.

47. As to claim 67, it includes the same limitations as in claim 47 above, and is similarly rejected under the same rationale.

48. As to claim 77, Nara teaches the interface device is also operably connected to *(electrically connected to...when inserted from card slot)* an integrated circuit card (*IC card 10*) via one of the one or more integrated circuit card interfaces to enable communication (*reads or writes data from or in a memory of IC card 10*) between the interface device and the integrated circuit card (*col.2, lines 17-33; col.3, lines 17-26; col.4, lines 46-51; and col.7, lines 60-67*).

Refer to the discussion of claim 57 above for rejection of “enable one or more programs to be added to, and/or deleted from, the interface device.”

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Response to Arguments

49. Applicant's arguments with respect to claims 2-9, 41, 43-54, and 57-77 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

50. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Daggar (US 5748737 A) "Multimedia electronic wallet with generic card"

Kodera (US 5038025 A) "Method of receiving program down-loaded to IC card and IC card thereof"

51. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Van H. Nguyen whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM – 6:00PM. The examiner can also be reached on alternative Friday.


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor Meng-Ai An can be reached on (571) 272-3756.

The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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